

REMARKS

Claims 1-4, 6-8, 10-25, 27, and 29-72 are pending in the subject application. In the present Office Action all claims stand rejected under 35 U.S.C. § 103(a) as being obvious over Wende, et al., *J. Am. Chem. Soc.*, 2001, 123, 11490-11491 ("Wende") or Curran et al., *Synlett*, 2001, 9, 1488-1496 ("Curran"). Applicants traverse these rejections for the reasons set forth herein.

Independent claims 1, 22, 45, and 58 have been amended herein to clarify that the claimed chemical reaction involves results in at least one product, "wherein the at least one product is a different chemical compound than the at least one chemical reactant and the fluororous compound." Support for this amendment may be found throughout the application, for example at page 10, paragraph 0029, and the Examples. Entry of the amendments places the application in condition for allowance and is respectfully requested.

General Comments

Applicants note that the Office Action fails to specifically address the expressly recited features any of the pending dependent claims. The subject application contains numerous dependent claims which further describe and limit the claimed invention. Under the Office's policy of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. (MPEP §707.07(g)). Accordingly, in the event that the Office maintains the rejection of any of the dependent claims, Applicant respectfully requests, in the interests of compact prosecution, that the Office apply art against each feature of each rejected dependent claim, on the record, and with specificity sufficient to support a *prima facie* case of anticipation or obviousness.

Rejection under 35 U.S.C. § 103(a) over Wende

The Office has indicated that "[t]he rejection under section 103 over Wende is withdrawn in view [of] Applicant's remarks" (Office Action, page 2, paragraph 1). However, the text of the Claim Rejections section still indicates that "[c]laims 1-4, 6-8, 10-25, 27, and

29-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wende et al., J. Am. Chem. Soc. 2001, 123, 11490-11491" (Office Action at page 2, paragraph 3). Clarification of the status of this rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a) over Curran

The Office rejects all pending claims under 35 U.S.C. § 103(a) as being unpatentable over Curran et al., *Synlett*, 2001, 9, 1488-1496 ("Curran"). Applicants traverse this rejection for at least the reasons set forth herein.

The Office states that the claims do not clearly require a chemical reaction and thus maintained the rejection over the Curran post-reaction separation techniques. The Office states that "[i]f the claims were amended to clearly require a chemical reaction, or that the product is a different chemical compound than the chemical reactant and the fluororous compound, the rejection would be withdrawn" (Office Action at paragraph spanning pages 2-3). In an effort to bring prosecution to a conclusion and as suggested by the Office, Applicants have amended all independent claims to clearly indicate that the claimed chemical reaction results in at least one product, "wherein the at least one product is a different chemical compound than the at least one chemical reactant and the fluororous compound." These amendments place the application in condition for allowance. In view of the amendment to independent claims 1, 22, 45, and 58 and the statement by the Office, Applicants respectfully request entry of the amendment, withdrawal of the rejection over Curran, and allowance of all pending claims.

In a phone interview between Examiner Puttlitz and Applicants representative (indicated below) on March 9, 2010, the currently presented amendment was discussed. Applicants thank Examiner Puttlitz for the courtesies extended during the phone interview. During the interview, the Examiner indicated that the amendment would result in withdrawal of the rejection, but that the amendment would raise new issues (i.e., that the claims require a chemical reaction) that would require an additional search of the prior art and could not be entered after the final rejection. Applicants respectfully disagree that the amendment raises new issues and submit that additional searches are unnecessary since subject matter related to a chemical reaction has been clearly presented in the pre-amended claims and subject of exhaustive searches in the previous office actions.

First, the claims and the specification are clearly drawn to a chemical reaction process. For example, the preamble of each independent claim clearly states that the claimed subject matter is drawn to "A method for conducting a chemical reaction using at least one chemical reactant and a fluorous compound in a non-fluorous medium" (emphasis added). Further, the body of each independent claim indicates that the method includes "changing at least one reaction condition" and that "the chemical reaction is conducted in the absence of a fluorous solvent" (emphasis added). Also, one having ordinary skill in the chemical arts would understand that the claim phrase "under conditions that form at least one product" (see, independent claims 1, 22, 45, and 58) indicates a chemical reaction and the term "product" would be clearly understood by one of ordinary skill as meaning a compound produced by a chemical reaction. Thus, one skilled in the art would understand that the claimed subject matter is drawn to a chemical reaction process and that the at least one product would be a different chemical compound than the chemical reactant and the fluorous compound.

In addition, the Office has already exhaustively searched the subject matter of chemical reactions, such as recited in claimed method. This is evidenced by the use of art references drawn to chemical reactions in previous Office Action rejections, for example the Wende reference (current and previous Office Action and Office Action of July 17, 2006); U.S. Patent No. 6,861,544 to Curran et al. (Office Action of July 29, 2008); U.S. Published Application No. 2005/0015936 by Eckert et al. (Office Action of October 16, 2007); U.S. Patent No. 6,815,390 to Vaughan et al. (Office Actions of May 31, 2007, December 12, 2006, and June 1, 2005); and U.S. Patent No. 6,734,318 to Curran et al. (Office Action of June 1, 2005). The Examiner characterizes each of these references as involving chemical reactions in his rejections (see previous Office Actions) and the rejections over each of the references were overcome by Applicants response. Thus, the Examiner's previous search strategies involved searches of chemical reactions. Applicants submit that the subject matter of the claimed method for conducting a chemical reaction has been completely searched and examined. Additional searches at this late stage of prosecution (the application has been pending for over 6.5 years) would be unproductive, duplicative, result in further delay, inconvenience, and expense to

Applicants, and would run counter to the Office's stated policy for compact prosecution and policy against piecemeal examination.

In view of these remarks, Applicants respectfully request entry of the amendments, withdrawal of the rejection under 35 U.S.C. § 103(a) over Curran and allowance of all claims.

Status of Pending Related Cases

Pending U.S. Application Serial No. 12/082,763, filed April 14, 2008 includes subject matter that may be related to the subject application. The '763 application is currently undergoing examination.

CONCLUSION

Applicants submit that claims 1-4, 6-8, 10-25, 27, and 29-72 of the subject application recite novel and non-obvious methods of conducting a chemical reaction in a non-fluorous medium using a fluororous compound in the presence of a solid adsorbant containing a fluororous domain. Amendments presented herein place the application in condition for allowance. Accordingly, entry of the amendments, withdrawal of the rejection, and issuance of a Notice of Allowance is earnestly solicited.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,



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Date

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